## REMARKS

Following entry of the amendment, 1-13, 15-17, and 25-36 will be pending in this application. Claims 1-13, 15-17, and 25-35 stand rejected as a result of the February 16, 2005 Office Action/Final Rejection. Claims 1, 8, 13, 17, 25, and 30 will have been amended. Claim 36 will have been added.

While applicants do not agree with the grounds for rejection and responses to argument, in the interest of furthering prosecution, applicants have amended all of the independent claims (1, 13, 17, 25, and 30) to more particularly point out the invention, which renders the stated grounds for rejection moot. (In amending the claims, applicants reserve their right to pursue the originally-filed and/or prior versions of those claims in an appropriate continuing application.) Applicants respectfully submit that the claims, as amended, define over the applied prior art.

Each of the independent claims now recites features relating to limits on inclusion in the list of web sites (or commerce sites, or computing devices) that are obtained by one of the claimed computing devices. For example, claim 1 recites a list of web sites that is accessible to a plurality of "second computing devices," and recites the feature of:

> limiting the set of web sites on said list to web sites that vend or distribute content that is renderable by said set of computer-executable instructions, and for which an first operator of said web site has met terms of an offer to be included in said list made by a second operator of said list.

As noted in response to a prior Office Action, the Examiner has found that the list, and the device on which it is maintained, corresponds to Sachs' description of "directory 26, stored on information services system 20." Even if this analogy to Sachs is applicable, Sachs does not teach or suggest that limiting inclusion on a web site can be based on either: (1) whether content is renderable by a particular set of computer-executable instructions; or (2) whether the terms of an offer made by an operator of the list have been met.

In a prior Office Action, the Examiner cited column 11, lines 20-44 of Sachs as teaching the type of "limit" on a list of web sites. For the Examiner's convenience, that portion of Sachs is quoted below:

> The electronic book services catalog is a dynamic list of all of the virtual bookstores in the virtual bookstore network. If the electronic book user's primary bookstore is the electronic

> bookstore, then the electronic book services catalog lists only the electronic bookstore and the customer support bookstore. None of the vertical bookstores are displayed.
>
> If the electronic book user's primary bookstore is a vertical bookstores, then the electronic book services catalog lists the vertical bookstore, the electronic bookstore, and the customer support bookstore. None of the other vertical bookstores are displayed.
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> If an electronic book user's primary bookstore is a vertical bookstore, they will be able to browse the content in the electronic bookstore, but they may be restricted by their vertical bookstore from purchasing content from the electronic bookstore. This kind of a restriction would apply to all electronic book users of a particular vertical bookstore.
>
> While this invention has been described with reference to illustrative embodiments, this description is not intended to be construed in a limiting sense. Various modifications of the illustrative embodiments, as well as other embodiments of the invention, which are apparent to persons skilled in the art to which the invention pertains are deemed to lie within the spirit and scope of the invention.

As can be seen, the quoted portion of Sachs may describe some limit as to which bookstores may be displayed to the user. However, the quoted portion does not in any way suggest that such a limit may be based on whether the bookstores vend content that is renderable by a particular set of computer-executable instructions, or whether an operator of such a bookstore has met the terms of an offer made by an operator of the list. There are certain claim features indicating that the list of bookstores in Sachs is not the same as the list of web sites (e.g., in claim 1, the list of web sites is stored on one device and provided to another device; in Sachs, there is no indication of which devices the list of bookstores is stored on or provided to, or of a relationship between any such devices). However, even if one assumes that Sachs' list of bookstores is analogous to the claimed list of web sites, there is no indication that inclusion on these lists is limited either by (1) whether the content is renderable by a set of computer-executable instructions that is provided to a different device than the one on which the list is stored, or (2) whether an operator of a bookstore has met the terms of an offer made by the operator of the list. (While the Examiner has applied Hoffman only to features that are unrelated to the features discussed above, applicants note that the features of claim 1 are not taught or suggested by Hoffman.)

Thus, applicants respectfully submit that claim 1 is patentable over the applied prior art.

Additionally, applicants wish to focus the Examiner's attention on the following related claim features. While each of the claims recites different features using different language – and applicants do not in any way imply that the claims listed below are co-extensive in scope with claim 1 – applicants direct the Examiner's attention to the following features concerning the constraints and/or criteria that govern whether a web site, commerce site, or device is included in a list. Applicants note that these features are not taught in Sachs:

- A directory of web sites where the "contents of said directory [are] limited based on a criterion that operators of said web sites having met the terms of an offer made by an operator of said directory" (claims 13 and 17)
- Storing data indicative of commerce sites at a first computing device that may be obtained by a second computing device, where "the set of commerce sites whose indicative data is obtained [is] limited based on a criterion that operators of said commerce sites have met terms of an offer, made by an operator of said first computing device, to be included among said commerce sites whose indicative data is to be provided" (claim 25).
- A first computing device that obtains an address of a third computing device from a second computing device, where "the address of said third computing device [is] included in a set of addresses, maintained by said second computing device, of computing devices whose addresses may be provided to said second computing devices, inclusion in said set being based on a condition of a first operator of said third computing device having met terms of an offer for said inclusion that has been made by a second operator of said first computing device to said first operator of said third computing device." (claim 30)

While the above-listed independent claims recite features relating to the meeting of the terms of an offer, applicants further note that dependent claims 8 and 36 also recite that the offer is to sell space in a directory or on a list. The applied prior art does not teach or suggest these features, and thus claims 8 and 36 are patentable for this additional reason.

For the foregoing reasons, claims 1, 8, 13, 17, 25, 30, and 36 are patentable over the applied prior art, and the remaining claims are patentable at least by reason of their dependency.

No new matter

The claim amendments do not constitute new matter, since they are supported by the original specification at least by Fig. 4, and page 13, lines 20-24.

Communication regarding other cases

Although applicants do not believe that the following cases will affect the Examination of this case, out of an abundance of caution applicants wish to advise the Examiner that U.S. Patent Applications Nos. 09/894,519 filed June 28, 2001 (which is the present application), 09/836,524 filed April 17, 2001, 09/837,904 filed April 19, 2001 and 09/839,784 filed April 20, 2001 are pending. The specifications of some of these applications share some substantially identical portions, or include overlapping material. Moreover, these applications have some overlap in their sets of inventors.

Conclusion

For all of the foregoing reasons, applicants respectfully submit that this case is in condition for allowance. Applicants thus request that the Examiner enter the after-final amendments, withdraw the Final Rejection, and issue a Notice of Allowance.

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